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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,866	09/29/2003	Guy Rousselin	1013-028	5362

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EXAMINER

FOX, JOHN C

ART UNIT	PAPER NUMBER
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3753

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/671,866
Filing Date: September 29, 2003
Appellant(s): ROUSSELIN, GUY

MAILED

SEP 05 2004

Group 3700

Allan M. Lowe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 7, 2006 appealing from the Office action mailed December 6, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is mostly correct. However, there is no disclosure that the whole diameter of a hole is always facing the outlet. The word "whole" does not appear in the original specification or claims.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 5 and 24-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure in the original application that the entire diameter of a hole is always exposed to the outlet.

(10) Response to Argument

The claim language “including holes such that the whole diameter of at least one of the holes always is facing the outlet regardless of the position of the disk about its axis of rotation” was added by amendment and does not appear anywhere in the original specification.

First, it should be noted that the stated purpose of the invention, to provide uninterrupted flow, can be achieved without having a whole diameter of a metering hole always facing the outlet. That is, even if only a portion of a hole always faced the outlet there would still be uninterrupted flow.

Figure 2 shows that in one position of the disc 6 a metering hole's entire diameter faces the outlet 11. However, the issue is whether this feature is present at all positions of the disc, and was disclosed as such in the original application.

There is no explicit disclosure of other positions of the disc, particularly at the end limits of rotation, i. e. the maximum and minimum flow conditions.

There is an original disclosure that at least one hole always faces the outlet. That is not the same as saying that the whole diameter of a hole always faces the outlet. If only a portion of a hole faced the outlet, it could accurately be so described. Indeed, in the Background Art section on page 1 of the specification, “facing the fluid inlet tube” implicitly means a portion of a hole allows flow. There clearly is no explicit disclosure in the original application that the whole diameter of a hole always faces the outlet.

There is an original disclosure in several places that the diameter of the outlet is greater than the distance, spacing or interval between two holes. In ordinary usage, the distance between two things does not include the things themselves. For example, if

one were to measure the dimensions of a room one would not include the thickness of the walls but would measure from the inside of one wall to the inside of the opposite wall, or an "in to in" measurement. The most reasonable, and the only unequivocal, interpretation of the disclosure is that the outlet diameter is greater than the maximum "in to in" spacing between two holes. For example, if at least portions of three holes were facing the outlet and two were 2 mm apart and two were 3 mm apart, the outlet diameter should be greater than 3 mm, to provide uninterrupted flow.

MPEP 2163.05 states that the failure to meet the written description requirement of 35 U.S.C. 112, first paragraph, commonly arises when, among other things, the claims are changed after filing to narrow the breadth of the claim limitations, which is the case here. To comply with the written description requirement of 35 U.S.C. 112, para. 1, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure.

There is no question but that the claim limitation at issue is not explicitly supported in the originally filed disclosure. The claim limitation at issue is not implicitly or inherently supported in the originally filed disclosure because it is not necessarily present in such disclosure. The stated object of the invention can be achieved with only portions of the hole(s) exposed to the outlet.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

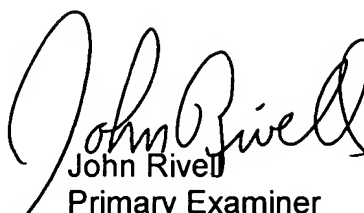


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